



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,381	09/15/2003	Andy Kazmierczak	DJORTH.220A	1613

20995 7590 10/25/2006

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

ALI, SHUMAYA B

ART UNIT	PAPER NUMBER
----------	--------------

3771

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/663,381

Applicant(s)

KAZMIERCZAK ET AL.

Examiner

Shumaya B. Ali

Art Unit

3771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 and 10-13 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 9 and 15-25 is/are rejected.
- 7) ☒ Claim(s) 26-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/27/06, 9/26/06, 2/6/06, 3/28/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

The declaration filed on 9/26/06 under 37 CFR 1.131 claiming priority to June 4, 2003 is acknowledged, however Itoi US 6,931,781 B2 has foreign priority data, JP 2003-002436 filed on January 8, 2003 and JP 2003-068426 filed on March 13, 2003, both of which are filed prior to June 4, 2003. Therefore, rejection filed on 6/5/2006 is maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, rejected under 35 U.S.C. 102(e) as being anticipated by Itoi US Patent 6,932,781 B2

As to claims 1,15, Itoi in figures 2 and 3 discloses a shoulder sling for supporting a wearer's arm at desired angles of abduction and external rotation, the sling comprising: a support pillow (10, see col.4 lines 27-30) including a contoured medial surface (3, col.4 lines 31-32) for abutting the wearer's torso, and a lateral surface (5) for operatively contacting and supporting the wearer's arm; a pouch (fig.3, 14) for receiving and at least partially enclosing the wearer's forearm; and a plurality of straps (2 and 9) for securing the support pillow and the pouch to the wearer, wherein a distance between anterior edges of the medial and lateral surfaces is substantially greater than a distance between posterior edges of the medial and lateral surfaces (as seen in figure 2) such that the wearer's arm is maintained in a position of external rotation (see col.4 lines 33-35).

As to claim 2, Itoi discloses wherein the support pillow retains the wearer's arm in a position of approximately 15° of abduction and approximately 15° of external rotation (see fig.7, col.3 lines 25-27; col.4 lines 14-20).

As to claim 3, Itoi discloses wherein the support pillow retains the wearer's arm in a position of approximately 15° of abduction and approximately 30° of external rotation (see fig.7, col.3 lines 25-27; col.4 lines 14-20).

As to claims 4, 17 Itoi discloses wherein a first one of the straps comprises a torso strap (2) that extends from the support pillow adjacent the anterior edge of the medial surface to the support pillow adjacent the posterior edge of the medial surface (as best seen in figure 2).

As to claims 8,16 Itoi discloses wherein the pouch is releasably secured to the support pillow later surface (as seen in figure 3, Velcro 7 allows releasable securement of pouch to the pillow)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5,6, 18-20, 23, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoi in view of Gaylord US Patent 6,659,971 B2 and in further view of Schaefer US Patent 4,598,701

As to claims 5,18, 19 Itoi discloses limitation as cited for claims 1-4 except for a second one of the strap comprises a chest strap that extends from an anterior surface of the support pillow to an anterior edge of a shoulder pad; However, at the time of the

invention such strapping attachment in combination with support pillow and pouch is well known in the art. **Gaylord** discloses shoulder sling with a second one of the straps comprises a chest strap (see fig.1 reference object 65) that extends from an anterior edge of a shoulder pad (see fig.1 reference object 80); **however does not disclose** the strap extends from the anterior edge of a shoulder pad to an anterior surface of the support pillow. **Schaefer** teaches a shoulder abduction splint wherein a chest strap (securing strap) (see fig.1 reference object 24) extends from an attachment joint at the shoulder to an anterior surface of a support pillow (see fig.1 reference object A). **Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the chest strap of Itoi in view of Gaylord and in further view of Schaefer in order to secure the strap that extends from an anterior surface of the support pillow to an anterior edge of a shoulder pad for the purposes of properly support the wearer's arm.**

As to claims 6,18,20 Itoi fails to disclose a third one of the straps comprise a back strap that extends from a posterior edge of the pouch to a posterior edge of the shoulder pad. However, at the time of the invention such strapping attachment in combination with support pillow and pouch is well known in the art. Gaylord discloses the shoulder sling limitation as applied to claim 5, wherein a third one of the straps comprise a back strap (see fig.3, reference object 55) that extends from a posterior edge of the pouch to a posterior edge of the shoulder pad (see col.7 lines 63-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify

the chest strap of Itoi in view of Gaylord in order to properly support the wearer's arm.

As to claim 23, Itoi in view of Gaylord teaches limitation as cited for claims 1, and 4-6.

As to claim 25, Itoi discloses Velcro hook (figure 1, 8) to secure the torso strap. It is well known in the art that buckles and hook and loop are alternative means for securing. Therefore, it would have been obvious to one of ordinary skills in the art to use buckle or other means for securing as a matter of design choice.

Claims 9,21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoi US Patent 6,932,781 B2, in view of Bastyr et al. US Patent 5,407,420.

As to claims 9,21, 24 Itoi discloses limitations as cited for claim 1 except for a resilient compressible member secured to an anterior surface of the support pillow. Bastyr et al. teaches an adjustable brace that provides stabilization and immobilization of the shoulder following injury comprising a spherical foam hand bolster attached to the distal end (anterior surface) of a forearm cuff to provide support for the hand and a means for exercising the arm while the shoulder is immobilized by firmly gripping the bolster with the hand (see fig.1 reference object 40, col.4 lines 64-68). Since Bastyr et. al. forearm is capable of abducting, extending, and rotating a wearer's arm (see col.5 lines 9-12,21-25), Bastyr et al. forearm cuff is considered to act as and meet the same purposes of the pillow disclosed by the applicant. Additionally, a close review of the applicant's

disclosure reveals that the purpose and the location of the resilient member are more critical than the specific attachment point. It is important that the member is located where the wearer can easily reach it with the hand on his or her treatment arm (see page 8). Therefore, both the applicant's and Bastyr et al. resilient compressible member are located where the wearer can easily reach it with the hand on his or her treatment arm. **Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add a resilient compressible member to the pillow of Itoi in view of Bastyr et al. for the purposes of providing support for the hand and a means for exercising the arm while the shoulder is immobilized by firmly gripping the bolster with the hand.**

Claim Objections

Claim 7 is objected to because of the following informalities: on page 3, second to the last line of claim 7; consider "a" shoulder pad instead of "the" shoulder pad. Appropriate correction is required.

Allowable Subject Matter

Claims 26-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 7, 10-13 are allowable over the prior art of record.

Conclusion

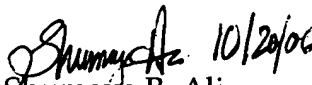
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shumaya B. Ali whose telephone number is 571-272-6088. The examiner can normally be reached on M-W-F 8:30am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 10/24/06
Shumaya B. Ali
Examiner
Art Unit 3771


Danton D. DeMille
Primary Examiner